



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,177	08/01/2001	Marshall Bandy	08100/0100	6432

3490 7590 01/29/2004

DOUGLAS T. JOHNSON  
MILLER & MARTIN  
1000 VOLUNTEER BUILDING  
832 GEORGIA AVENUE  
CHATTANOOGA, TN 37402-2289

EXAMINER

HOLLOWAY III, EDWIN C

ART UNIT

PAPER NUMBER

2635

DATE MAILED: 01/29/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/920,177

Applicant(s)

BANDY ET AL.

Examiner

Edwin C. Holloway, III

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☒ Claim(s) 15-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 2635

**EXAMINER'S RESPONSE**

1. In response to the application filed 8-1-01 and abstract filed 10-5-01, the application has been examined. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

***Specification***

2. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. A hyperlink is included on page 17 paragraph 00054. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

***Claim Objections***

3. Claims 15-16 are objected to because of the following informalities: Claim 15 recites "the fire alarm monitor" of claim 14, but depends from claim 12. Appropriate correction is required.

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed.

Art Unit: 2635

Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 6625464.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are generally broader than the claims in your patent. Broader claims in a later application constitute obvious double patenting of narrow claims in an issued patent. See *In re Van Ornum and Stang*, 214, USPQ 761, 766, and 767 (CCPA) (the court sustained an obvious double patenting rejection of generic claims in a continuation application over narrower species claims in an issued patent); *In re Vogel*, 164 USPQ 619, 622, and 623 (CCPA 1970) (generic application claim specifying "meat" is obvious double patenting of narrow patent claim specifying "pork").

**Claim Rejections - 35 USC § 102 & 103**

6. The following is a quotation of the appropriate paragraphs

Art Unit: 2635

of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 4-6, 9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Payne (US 6021433). Payne discloses a

Art Unit: 2635

system and method for transmission of data including information generator 12, transmitting device 106/108/110/112 processing station 114, radio transmitter 41 and receiver 32 operating in the manner of claim 1 in col. 7 line 57 - col. 10 line 36.

Regarding claims 4-6, Payne includes a serial number and command to add/delete (activate/deactivate) information codes in col. 31 line 45 - col. 32 line 18. Regarding claim 9, Payne includes servers that monitor email and send notification of new email in col. 11 line 54 - col. 12 line 4. Regarding claim 11 the information code of Payne is a capcode in col. 9 line 42 - col. 10 line 36.

10. Claims 1-3, 11-12, 14 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Raizen (US 4692742). Raizen discloses a security system and method including information generator 102/202/302, transmitting device 103/203/303 processing station 4/fig. 2, radio transmitter 10 and receiver 101S/201S operating in the manner of claim 1 in col. 3 line 1 - col. 4 line 42. Note that the receiver is a commercially available such as a programmable Motorola Sprint Pager. Regarding claims 2, 12 and 14, Raizen includes a sensor 101/201/301 that functions as a fire alarm monitor. Regarding claims 3 and 19, Raizen includes assigning physical ID numbers with physical locations (zones) in col. 3 line 36 that is

Art Unit: 2635

corresponds with a subscriber account identifying an associated receiver address in col. 4 lines 26-39. Regarding claim 11 the address of the pager in Raizen is a capcode.

11. Claims 1-6, 8-9, 11-12, 14, 19-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payne (US 6021433) in combination with Liebesny (US 5131020). Payne was discussed above. Liebesny discloses a method and system for transmission of updated information including information generator 3/5/7/11/12/9/17/19, transmitting device 1/14/15/21, processing station 23, radio transmitter 31 and receiver CT/A/V operating in the manner of claim 1 in col. 3 line 19 - col. 5 line 27. Liebesny differs from claim 1 by not expressly disclosing programming the receiver ID.

Regarding claim 1, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the address programming of Payne in the method of Liebesny in order to allow activation/deactivation of desired subscription services. Alternatively it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Payne the protocol of Liebesny to allow continually updated information.

Regarding claims 2 and 12, Liebesny includes a sensor 19. Regarding claims 3, 19-20 and 22 Liebesny includes assigning

Art Unit: 2635

physical ID numbers with physical locations (geographical zones) in col. 6 lines 41-55 to limit information such as traffic information to a location of interest. Regarding claims 4-6, Payne includes a serial number and command to add/delete (activate/deactivate) information codes in col. 31 line 45 - col. 32 line 18. Regarding claim 8, Liebesny includes weather in col. 4 line 28 and col. 10 line 25. Also, Payne includes weather in col. 8 line 1 and col. 11 line 66. Locality would have been obvious in view of the zones of Liebesny to limit information to a location of interest. Regarding claim 9, Payne includes servers that monitor email and send notification of new email in col. 11 line 54 - col. 12 line 4. Regarding claim 11 the information code of Payne is a capcode in col. 9 line 42 - col. 10 line 36. Regarding claim 14, Liebesny includes a fire alarm monitor 5.

12. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Payne (US 6021433) alone or in combination with Liebesny (US 5131020) as applied above and further in view of Fascenda (US 5241341). Fascenda disclose a method for programming paging receiver addresses including a serial number and add/delete command in col. 11 lines 22-61. This permits companies involved to ensure only authorized pagers receive messages and can revoke authority if a user fails to pay without



Art Unit: 2635

having to obtain physical possession of the pager. Therefore, the addresses are accessible to the companies involved, not the user. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Payne or Liebesny added addresses not accessible to the user as disclosed in Fascenda so companies involved can ensure only authorized pagers receive messages.

13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Payne (US 6021433) alone or in combination with Liebesny (US 5131020) as applied above and further in view of Duceck (US 5303401). Duceck disclose a method for communicating with a receiver using a PI code to identify regions or zones to limit received message to a location of interest. See the abstract, col. 2 lines 20-39 and col. 3 line 55 - col. 4 line 2. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Payne or Liebesny the PI code of Duceck to limit messages to a location of interest.

14. Claims 13-14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payne (US 6021433) and Liebesny (US 5131020) as applied above and further in view of Blanchard (US 4558181). Blanchard disclose a method monitoring alarms that sends a telephone number with a message to allow callback in

Art Unit: 2635

col. 2 lines 35-68. Blanchard includes water level and fire sensors in col. 2 lines 29-30 col. 9 lines 5-11 to detect flooding. Regarding claim 13, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the water level sensor of Blanchard to detect flooding. Regarding claims 14 and 17, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the communication telephone number associated with a fire alarm monitor in Blanchard to allow call back.

15. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Payne (US 6021433), Liebesny (US 5131020) and Blanchard (US 4558181) as applied above and further in view of Holland (US 4641343). Holland discloses a voice recognition circuit in the form of a speech analyzer that can detect a fire alarm in col. 3 lines 29-38. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the voice recognition circuit of Holland to detect fire alarm sound with the advantage of being software programmable.

16. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Payne (US 6021433), Liebesny (US 5131020),

Art Unit: 2635

Blanchard (US 4558181) and Holland (US 4641343) as applied above and further in view of Nishihara (US 4897862). Nishihara discloses an acoustic alarm detection system that requires a predetermined count such as 8 cycles to discriminate from background or spurious noise in col. 6 line 51 - col. 7 line 8. A count of 8 comprises the 3 trigger signals of claim 15. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the count of 3 triggers as disclosed in Nishihara discriminate from background or spurious noise.

17. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Payne (US 6021433) and Liebesny (US 5131020) as applied above and further in view of Boone (US 4713661).

Boone disclose a method that includes a school bus stop reporter in col. 3 lines 4-9 and col. 5 line 3 - col. 6 line 64. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the school bus stop reporter of Boone to alert a parent or student as to bus location in adequate time for the student to leave home and travel to the designated stop.

18. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Payne (US 6021433) and Liebesny (US 5131020) as applied above and further in view of Mardus (US 5095532).

Art Unit: 2635

Mardus disclose a method that includes traffic announcements with a location code identifying a road segment in the abstract and col. 5 lines 40-51 so that the driver is not distracted by irrelevant traffic advisories. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the location code identifying a road segment of Mardus so that the driver is not distracted by irrelevant traffic advisories.


#### CONTACT INFORMATION

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology center 2600 receptionist whose telephone number is (703) 305-4700.

Facsimile submissions may be sent via fax number (703) 872-9314 to customer service for entry by technical support staff. Questions regarding fax submissions should be directed to customer service voice line (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (703) 305-4818. The examiner can normally be reached on M-F (8:30:-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704.

EH  
1/25/04

  
EDWIN C. HOLLOWAY, III  
PRIMARY EXAMINER  
ART UNIT 2635